SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor

HIGH COURT (KUALA LUMPUR) — SUIT NO D5-(IP)-22–800 OF 2008
AZAHAR MOHAMED J
4 OCTOBER 2010

Patents — Infringement — Anticipation and novelty — Whether plaintiff's patent invention that was new or had novelty — Whether plaintiff's patent involved inventive step — Whether requirement for inventive step had been met — Whether witness was notional skilled man — Whether plaintiff's patent valid and subsisting at all times — Patents Act 1983 ss 11, 14 & 15

Trademarks — Passing off — Distinctiveness and goodwill — Whether shown — Whether defendants' trademark was distinguishable from plaintiff's trademark

The plaintiff, the registered owner of the patent in respect of rolling shutters (the plaintiff's patent), manufactured and distributed roller doors and shutters (the plaintiff's products), which incorporated its patent. The plaintiff's products were marketed and promoted under the name SKB VISION 7, a trademark owned by the plaintiff in Malaysia. The plaintiff claimed that the first and second defendants had infringed the plaintiff's patent by making, selling, and using products that incorporated features of the plaintiff's patent (the infringing products) without the consent or license of the plaintiff. The plaintiff also claimed that in marketing and/or selling the infringing products the defendants were likely to misrepresent to consumers and the industry that the said infringing products originated from the plaintiff or were associated with the plaintiff's products. The plaintiff thus commenced an action against the defendants for patent infringement and passing off by which it sought, inter alia, a declaration of infringement and passing off, a permanent injunction and damages. Insofar as the patent infringement was concerned, the defendants contended that they could not be held to infringe the plaintiff's patent because the said patent was invalidated. The defendants sought to prove that the plaintiff's patent was not a patentable invention by showing that it was not new and did not involve an inventive step and also did not meet all the patentability requirements in particular ss 11, 14 and 15 of the Patents Act 1983 ('the Act'). Insofar as the alleged passing off was concerned, the defendants contended that the allegedly infringing products, which were marketed under the mark SK-PC 7, which the plaintiff alleged were similar to the plaintiff's patented products did not create any deception or confusion among the public to be mistaken for the plaintiff's products. The defendants

thus counterclaimed for a declaration that the plaintiff's patent was invalid and unenforceable and an order that the plaintiff's patent be revoked and invalidated. The defendants argued that the plaintiff's patent was an invention that was neither new or had novelty because it had already been publicly available in the market in the form of the exhibits it adduced ('the PVC piece'). The defendant further submitted that the plaintiff's patent did not involve an inventive step. In order to support this submission the defendants placed heavy reliance on their witness (DW3), a self admitted inventor who had invented several patents.

Held, allowing the plaintiff's claim in part and dismissing the defendants' counterclaim with costs:

(1) It was found that the plaintiff's patent was substantially different from the PVC piece tendered in evidence by the defendants. The plaintiff's patent had three parts as opposed to the PVC piece which comprised of two physical parts. Further the PVC piece did not give sufficient and clear teaching to arrive at the plaintiff's patent. Since the defendants had failed to establish that the plaintiff's patent had been anticipated by the PVC piece it was clear that the invention in the plaintiff's patent was novel (see paras 18–19).

(2) In determining whether the requirement for inventive step had been met the court had to ask itself whether viewed without knowledge of the alleged invention, the differences that existed between what was already common general knowledge and the alleged invention constituted steps that would have been obvious to the skilled man or whether they required any degree of invention. Although the defendants relied heavily on the testimony of DW3 to prove that the plaintiff's invention did not involve an inventive step, the court found that DW3 was not a notional skilled man as he did not possess common general knowledge, which had to be distinguished from public knowledge. In the present case common general knowledge referred to knowledge in the context of the roller shutter industry but DW3 had admitted that he was not related to the roller shutter industry. On the other hand the plaintiff's witness an experienced manufacturer of roller shutter doors was found to possess the common general knowledge of those in the roller shutter industry (see paras 21, 25–26).

(3) Taking the evidence as a whole and having considered the terms of the plaintiff's patent in the light of the three pieces of prior art, which were identified as relevant, it was found that the invention of the plaintiff's patent involved an inventive step that was not obvious to a person skilled in the art. Since the plaintiff's invention was novel and inventive, the plaintiff's patent was valid and subsisting at all times and it must follow that the defendants had infringed the plaintiff's patent (see paras 42–43).

(4) In the present case the plaintiff had neither shown any evidence of distinctiveness and goodwill attached to the features found in the plaintiff's roller shutter nor shown that the consumer was able to identify the features found in the plaintiff's roller shutter. Further, the defendants' SK-PC 7 mark was visually, aurally and conceptually distinguishable from the plaintiff's SKB VISION 7 mark. As such, the plaintiff's passing off claim must fail (see para 44).

[Bahasa Malaysia summary

Plaintif, pemilik berdaftar paten bagi *rolling shutters* (paten plaintif), mengeluar dan mengedarkan *roller doors* dan *shutters* (produk-produk plaintif), yang membentuk patennya. Produk-produk plaintif dipasarkan dan dipromosi di bawah nama SKB VISION 7, tanda dagangan yang dimiliki plaintif di Malaysia. Plaintif mendakwa bahawa defendan pertama dan kedua telah melanggar paten plaintif dengan membuat, menjual dan menggunakan produk-produk yang menggunapakai ciri-ciri paten plaintif (produk-produk yang melanggar) tanpa kebenaran atau lesen daripada plaintif. Plaintif juga mendakwa bahawa dalam memasar dan/atau menjual produk-produk yang melanggar itu, defendan-defendan berkemungkinan akan melakukan salah nyataan kepada pengguna-pengguna dan industri bahawa produk-produk yang melanggar tersebut adalah daripada plaintif atau dikaitkan dengan produk-produk plaintif. Oleh itu plaintif memulakan tindakan terhadap defendan-defendan untuk pelanggaran paten dan kelirupaan yang mana ia memohon, antara lain, suatu perisytiharan pelanggaran dan kelirupaan, injunksi tetap dan ganti rugi. Berikutan pelanggaran paten, defendan-defendan berhujah bahawa mereka tidak boleh dikatakan melanggar paten plaintif kerana paten tersebut tidak disahkan. Defendan-defendan memohon untuk membuktikan bahawa paten plaintif bukanlah ciptaan yang boleh dipatenkan dengan menunjukkan bahawa ia bukan baru dan tidak melibatkan usaha-usaha berdaya cipta dan juga tidak memenuhi semua kehendak paten terutamanya ss 11, 14 dan 15 Akta Paten 1983 ('Akta'). Berkaitan dengan dakwaan kelirupaan, defendan-defendan berhujah bahawa produk-produk yang melanggar yang didakwa, yang dipasarkan di bawah tanda SK-PC 7, yang mana plaintif dakwa serupa dengan produk-produk plaintif yang dipatenkan tidak menimbulkan penipuan atau kekeliruan di kalangan umum yang akan dianggap sebagai produk-produk plaintif. Defendan-defendan oleh itu menuntut balas untuk suatu perisytiharan bahawa paten plaintif tidak sah dan tidak boleh digunapakai dan suatu perintah bahawa paten plaintif dibatalkan dan ditaksahkan. Defendan-defendan berhujah bahawa paten plaintif bukan merupakan rekaan baru atau kebaruan kerana ia boleh didapati dalam pasaran dalam bentuk ekshibit yang dikemukakan ('potongan PVC'). Defendan-defendan selanjutnya berhujah bahawa paten plaintif tidak melibatkan usaha-usaha daya cipta. Untuk menyokong hujah ini, defendan-defendan bergantung kepada saksi mereka (DW3), seorang pencipta yang telah mencipta beberapa paten.

Diputuskan, membenarkan sebahagian tuntutan plaintif dan mengenepikan tuntutan balas defendan-defendan dengan kos:

(1) Didapati bahawa paten plaintif adalah berbeza secara substansial daripada potongan PVC yang dikemukakan sebagai keterangan oleh defendan-defendan. Paten plaintif mempunyai tiga bahagian berbanding dengan potongan PVC tersebut yang terdiri daripada dua bahagian fizikal. Selanjutnya, potongan PVC tersebut tidak memberikan gambaran yang mencukupi dan jelas untuk mencapai kepada paten plaintif. Disebabkan defendan-defendan gagal membuktikan bahawa paten plaintif telah direka menerusi potongan PVC tersebut, adalah jelas bahawa ciptaan dalam paten plaintif adalah asli (lihat perenggan 18–19).

(2) Dalam menentukan sama ada kehendak untuk usaha-usaha daya cipta telah dipenuhi, mahkamah harus mempersoalkan sama ada apabila dilihat tanpa pengetahuan tentang rekaan yang didakwa itu, perbezaan antara apa yang sudah sedia menjadi pengetahuan am dan rekaan yang didakwa itu melibatkan usaha-usaha yang tentunya jelas kepada orang yang berkemahiran atau sama ada ia memerlukan ijazah dalam rekaan. Walaupun defendan-defendan bergantung kepada keterangan DW3 untuk membuktikan rekaan plaintif tidak melibatkan usaha-usaha daya cipta, mahkamah mendapati bahawa DW3 bukanlah secara konsepsinya orang yang berkemahiran kerana dia tidak mempunyai pengetahuan am bersama, yang mana harus dibezakan dengan pengetahuam awam. Dalam kes ini, pengetahuan am bersama merujuk kepada pengetahuan dalam konteks industri *roller shutter* tetapi DW3 mengakui bahawa dia tiada kena mengena dengan industri *roller shutter*. Sebaliknya, saksi plaintif merupakan pengeluar pintu-pintu *roller shutter* yang berpengalaman mempunyai pengetahuan am bersama bagi mereka yang terlibat dengan industri *roller shutter* (lihat perenggan 21, 25–26).

(3) Mengambilkira keterangan secara keseluruhannya dan mempertimbangkan kesemua terma paten plaintif melihat kepada tiga potongan hasil seni perusahaan sebelum ini, yang telah dipastikan relevan, didapati bahawa ciptaan paten plaintif melibatkan usaha-usaha daya cipta yang tidak ketara kepada individu berkemahiran dalam seni perusahaan tersebut. Memandangkan ciptaan plaintif adalah asli dan berdaya cipta, paten plaintif adalah sah dan wujud selama ini dan oleh itu defendan-defendan telah melanggar paten plaintif (lihat perenggan 42–43).

(4) Dalam kes ini, plaintif tidak menunjukkan apa-apa keterangan sifat tersendiri dan muhibbah perniagaan yang merujuk kepada ciri-ciri yang tedapat dalam *roller shutter* plaintif dan juga tidak menunjukkan bahawa pengguna boleh mengenalpasti ciri-ciri yang terdapat pada *roller shutter* plaintif. Selanjutnya, tanda SK-PC 7 milik defendan-defendan secara

pandangannya, aura dan konsepnya boleh dibezakan daripada tanda SKB VISION 7 milik plaintif. Oleh itu, tuntutan kelirupaan plaintif gagal (lihat perenggan 44).]

Notes

For cases on anticipation and novelty, see 10 *Mallal's Digest* (4th Ed, 2008 Reissue) paras 1098–1100.

For cases on passing off generally, see 12 *Mallal's Digest* (4th Ed, 2005 Reissue) paras 2050–2123.

Cases referred to

Brooks v Steele & Currie (1896) 14 RPC 46, CA (refd)

Cadbury Schweppes Pty Ltd and others v Pub Squash Co Pty Ltd (1980) 32 ALR 387, PC (refd)

Electric & Musical Industries Ltd & Boonton Research Corporation Limited v Lissen Ltd; Electric & Musical Industries Ltd and Boonton Research Corporation Ltd v G Kalis (trading as Andy's Radio Supplies) (Consolidated) (1939) 56 RPC 23, HL (refd)

General Tire & Rubber Company, The v The Firestone Tyre and Rubber Company Limited and others [1972] RPC 457, CA (refd)

ICI (Pointer's) Application [1977] FSR 434 (refd)

Lilly Icos Ltd v Pfizer Ltd [2001] 59 BMLR 123, CA (refd)

Nicaro Holdings Pty Ltd v Martin Engineering Co (1990) 16 IPR 545, FC (folld)

Non-Drip Measure Co Ltd v Strangers Ltd (1943) 60 RPC 135, HL (refd)

Technograph Printed Circuits Limited v Mills & Rockley (Electronics) Limited [1972] RPC 346, HL (refd)

Windsurfing International Inc v Tabur Marine (Great Britain) Ltd [1985] RPC 59, CA (folld)

Wood v Gowshall Ltd (1937) 54 RPC 37, CA (refd)

Legislation referred to

Patents Act 1983 ss 11, 14, 15, 56

Kuek Pei Yee (Janice Sim and Joel Lim with her) (Skrine) for the plaintiff.
SF Wong (CY Loi with him) (Shearn Delamore & Co) for the defendants.

Azahar Mohamed J:

[1] The dispute in this action revolves around Malaysian Patent Number MY-128431-A ('the plaintiff's patent') and the trademark 'SKB VISION-7'. The plaintiff's claim against the defendants is for patent infringement and passing off.

[2] To make the point under discussion easier to understand, it is useful to state briefly the rival contentions of the parties in this action.

THE PLAINTIFF'S CASE

[3] The plaintiff is the registered owner of the plaintiff's patent in respect of a rolling door or rolling shutter. The said patent was granted on 31 January 2007 and is at all times valid and subsisting. The invention provides an arrangement wherein a door curtain (that may be formed of a transparent material), may be assembled. The plaintiff manufactures and distributes roller doors and roller shutters that incorporates the invention under the said patent, which are marketed and promoted under the name 'SKB VISION 7'.

[4] The plaintiff is also the registered owner of Trade Mark Registration No 98009483 'SKB VISION 7' in Malaysia for goods and services in class 6. The features of the said patent in the plaintiff's products together with mark 'SKB VISION 7' are associated with the plaintiff within the industry and by consumers.

[5] The plaintiff claims that the first and second defendants have, while the said patent is valid and subsisting, infringed the said patent by making, selling, offering to sell and using, without the consent or license of the plaintiff, products that incorporate features of the said patent (the infringing products).The features of the infringing products that constitute infringement of the plaintiff's patent included, among other things:

(a) an elongated body member having its edges fixed and arranged with an engagement means that engages complementary engagement means on the adjacent edge of another panel;

(b) the engagement means on the panel comprises a bracket member mounted on the respective edges extending substantially along its length, and a flange extending from the said bracket member transversely to the edges;

(c) the flange comprises a link portion and an engagement portion with a curved cross-section with a curvature which engages the engagement portion of a flange extending from a bracket member mounted on an adjacent edge of another panel; and

(d) the body member is made of transparent material. The infringing products further bear the mark 'SK-PC 7'.

[6] The plaintiff claims that further, the first and second defendants' actions in manufacturing, distributing and/or selling the infringing products have and/or is likely to misrepresent to consumers and the industry that the

infringing products that incorporate the features of the said patent and the mark 'SK-PC 7' (which is similar to SKB VISION 7) originates from the plaintiff or is otherwise associated with the plaintiff's products or the plaintiff, when such is not the case and therefore amounts to the tort of passing off.

[7] In the above premises, the plaintiff claims against the first and second defendants for, inter alia, a declaration of infringement and passing-off, a permanent injunction, and damages.

THE DEFENDANTS' CASE

[8] In summary, insofar as alleged patent infringement is concerned, the defendants' contentions are as follows. The alleged invention in the plaintiff's patent is, as at its priority date of 24 February 1997, not a proper subject for protection both in law and on the facts. The said patent was wrongly granted, wrongfully remaining on record and invalid in all respects. The said patent is not new and not inventive and does not meet all the patentability requirements, particularly, ss 11, 14, and 15 of the Patents Act 1983 ('the Act'). The defendants are no longer involved in the manufacture or sale of the allegedly infringing product roller doors since 2007.

[9] Insofar as alleged passing off is concerned, the defendants' contention are that the plaintiff's roller doors which incorporate the features of the plaintiff's patent are functional and common to the trade, industry and public; and thus cannot be said to be distinctive of the plaintiff. The defendants' use of their roller doors under the mark SK-PC 7 or of shapes and features of configuration allegedly similar to the product of the said patent prior to 2007 did not result in or create any deception or confusion among the public that they are the roller doors of the plaintiff.

[10] The defendants counterclaim for:

(a) a declaration that the plaintiff's patent is and has always been invalid and unenforceable; and

(b) an order the plaintiff's patent be revoked and invalidated and that upon the order be served on the registrar, the registrar may take such action as may be necessary to revoke and remove from the register patent under serial No MY-128431A including the publication of such revocation in the relevant government gazette.

THE FORM AND SCOPE OF THE PLAINTIFF'S PATENT

[11] Before dealing with specific issues which arise for determination, it is important to understand the form and scope of the plaintiff's patent. It is

worth noting that a patent is a limited monopoly that is granted for the disclosure of technical and industrial information (see *Intellectual Property Law* by Lionel Bently and Brad Sherman, (3rd Ed), p 335). Patents reward a patentee for making and disclosing an invention. Under the Act, a patent provides protection for a period of 20 years from the date of filing. A patent owner has the exclusive right to use or exploit the patented invention, or may license to other parties to use the invention, or sell the right of the invention who will in turn become the new owner of the patent. Therefore, the function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the area within which they will be trespassers (see *Electric & Musical Industries Ltd & Boonton Research Corporation Limited v Lissen Ltd; Electric & Musical Industries Ltd and Boonton Research Corporation Ltd v G Kalis (trading as Andy's Radio Supplies) (Consolidated)* (1939) 56 RPC 23). In the present case, the invention that is claimed by the plaintiff patents is well summarised by learned counsel for the plaintiff in her submissions, which I agree, as follows:

(a) Claim 1 — is essentially a panel suitable for use in a rolling door of the type, including a door curtain supported on a roller assembly for movement between open and closed position; comprising:

(i) an elongated body member [21] (the 'Slat') having a first longitudinal edge [53] (the 'First Edge') and a second longitudinal edge [54] (the 'Second Edge');

(ii) The first engagement means (the 'First Bracket') is positioned on the said First Edge and second engagement means (the 'Second Bracket') positioned on the said Second Edge, each arranged so as to engage complementary engagement means ('Brackets') on an adjacent edge of another panel to link the panels and thereby form the said curtain door

(iii) The First and Second Brackets each comprises a bracket member [27, 28] mounted on the First Edge or said Second Edge, as appropriate, and extending substantially along its length; and a flange [49, 52] (the 'Flange') extending from the said bracket member substantially transversely to the said First Edge or said Second Edge, said Flange comprising a link portion [45, 46] and an engagement portion [47, 48] (the 'Interlocking Scroll'), wherein the said Interlocking Scroll has a curved cross-section with a curvature suitable to engage the Interlocking Scroll of a Flange extending from a bracket member mounted on an adjacent edge of another panel; and

(iv) The said bracket member has a base [31, 34], a first arm [29, 33] and second arm [30, 32], each arm extending substantially

transversely from said base so that the said bracket member is substantially U-shapes in cross-section.

(b) Claim 2 — refers to a panel as claimed in claim 1 above, wherein the said first arm [29, 33] includes an inwardly projecting nib [35, 36] which is received in a complementary groove [41, 42] in the said Slat.

(c) Claim 3 — refers to a panel as claimed in either claim 1 or claim 2 above, wherein the said second arm [30, 32] includes a thickened portion [37, 38], at its end from which it tapers [39, 40] towards the said base [31, 34], and said Slat includes an indentation [42, 44] complimentary in shape in which said second arm is received.

(d) Claim 4 — refers to a panel as claimed in any one of claims 1 to 3 above, wherein the said link portion [45, 46] extends from the base [31, 34] of the said bracket [27, 28], substantially transversely thereto, and in the opposite direction to said first arm [29, 33] and said second arm [30, 32].

(e) Claim 5 — refers to a panel as claimed in claim 4 wherein said link portion [45, 46] is aligned with either said first arm [29, 33] or said second arm [30, 32].

(f) Claim 6 — refers to a panel as claimed in any one of the preceding claims above wherein the said Slat and said bracket member [27, 28] are fixed together.

(g) Claim 7 — refers to a panel as claimed in claim 6 above, wherein said Slat and said bracket member [27, 28] are screwed together.

(h) Claim 8 — refers to a panel as claimed in any one of the preceding claims above wherein said Slat is manufactured from a plastics material.

(i) Claim 9 — refers to a panel as claimed in claim 8 above wherein said plastics material is transparent.

(j) Claim 10 — refers to a rolling door [20] of the type including a door curtain [51] supported on a roller assembly [50] for movement between open and closed positions comprising a plurality of panels as defined in any one of claims 1 to 9 arranged so that said First Bracket on one panel engages the said Second Bracket on the adjacent panel to link the panels and thereby form the said door curtain.

(k) Claim 11 — refers to a panel suitable for use in a rolling door [50] of the type including a door curtain [51] supported on a roller assembly [50] for movement between open and closed positions; comprising a Slat having a First Edge and a Second Edge; and First Bracket positioned on said First Edge and Second Bracket positioned on said Second Edge, each arranged so as to engage complementary Brackets on an adjacent edge of another panel to link the said panels and thereby form the said door curtain; characterised in that said Slat is made of a transparent material.

FINDINGS OF COURT ON THE ISSUE OF PATENT INFRINGEMENT

[12] Now, the defendants have put in issue the validity of the plaintiff's patent by way of defence to the plaintiff's pleaded cause of action that they have infringed the said patent. The defendants have elected to invalidate the plaintiff's patent. In this way, if the plaintiff's patent is invalidated, the defendants cannot be held to have infringed the plaintiff's patent. On the other hand, if the defendants are unsuccessful in their case for invalidation, it must inevitably follow they have infringed the plaintiff's patent.

[13] In my view, the defendants are aggrieved persons on the basis of their pleaded case; they may apply to court to invalidate the plaintiff's patent on any of the grounds set out in s 56 of the Act. Very broadly stated, the defendants' grounds are that the invention of the plaintiff's patent is not a patentable invention as it is not new and does not involve an inventive step. I shall deal with each of them in turn.

NOVELTY

[14] First is the issue whether the invention of the plaintiff's patent is new or otherwise. That is to say, it must have novelty. Newness is a requisite for patentability. In order to consider the nature of novelty, it is necessary to bear in mind s 14 of the Act. The aim of novelty means that the conferral of a monopoly will do two things. First is to create an incentive and, secondly in exchange for requiring the patentee to make known new details of the invention.

[15] The Act therefore requires an invention to be new in the sense that on the date of filing of patent application, it should not form a part of the state of the art. The invention is not novel if it is anticipated by prior art and prior art consists of everything disclosed to the public anywhere in the world by written publication, oral disclosure and by use or in any other way before the priority date of the patent application claiming the invention. The plaintiff's patent does not claim any priority filing date from an earlier application, hence its application date of 24 February 1997 is its priority date. The priority date is the date by which the novelty of the invention is to be judged. In order for any prior art to provide sufficient disclosure, the disclosure must be enabling in nature, that is to say, giving sufficient and clear instructions or teachings to arrive at the disputed invention. Mere suggestions will not be sufficient disclosure. In *The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others* [1972] RPC 457 it was held:

> If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that it to say, it will have been anticipated … To anticipate the patentee's claim the prior publication must contain clear and unmistakeable directions to do what the patentee claims to have invented: *Flour Oxidizing Co Ltd v Carr & Co Ltd (* (1908) 25 RPC 428 at p 457, line 34, approved in *BTH Co Ltd v Metropolitan Vickers Electrical Co Ltd* (1928) 45 RPC 1 at p 24, line 1). A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee.

[16] In *Nicaro Holdings Pty Ltd v Martin Engineering Co* (1990) 16 IPR 545, it was held that the prior art must enable the notional skilled addressee at once to perceive and understand and be able to apply the discovery without the necessity of making further experiments. I will have a lot to say afterwards about such a person. Suffice to say at this point that the notional skilled person in the context of anticipation is a non-inventive person in the sense that when considering the prior art, he is not inclined to carry out experiments with a view to find out something not already disclosed.

[17] That being the principles to be applied, I turn to deal with the points raised by learned counsel for the defendants. He argued that the plaintiff's patent is not new as it had already been anticipated by prior art both in the form of prior disclosure and prior use at a point in time before the filing on 24 February 1997. His primary contention is that the prior art that anticipated the invention of the plaintiff's patent is the public availability in the market and the use of the article as per exh D12 and/or D18 (the PVC piece). It is the contention of the defendants that the joining of the slat to the bracket using the male and female tongue and groove method is disclosed in the PV piece. Further on this point, the contention of the defendants is that the pivotal hinging of panels using the interlocking scrolls is equally disclosed in the PV piece.

[18] I find myself quite unable to agree with the contention of learned counsel for the defendants on this issue. My reasons now follow. In my view the PVC piece does not contain clear and unmistakeable directions to do what that the inventor claims to have invented in the plaintiff's patent. The plaintiff's patent is substantially different. The PVC piece comprises of two physical parts as opposed to plaintiff's patent that has three. It is further observed that the illustrations depicted in exh ID17 are not accurate as it does not represent an accurate cross-section view of the PVC piece. Mr Yap Mew Sang ('DW3') had attempted to depict the PVC piece by breaking it into three pieces. More will be said about the evidence of DW3 later in this judgment. In my view, there must be a significant amount of tampering with exh D12 and D18 as the links

of the single piece aluminium frame of the PVC piece must be cut and altered in order for it to be viewed as a three part product. In this way, there are no clear teachings or instructions that would lead a person skilled in the art to remove the purported links from the PVC piece. That is to say in fact any person intending to do so would be venturing into an inventive and exploratory effort. Most important, the fact that the removal of the links in the PVC piece would render the product completely unusable unless significant alterations are further made to the product. This has been explained by Mr Sin Kheng Lee (PW1), the inventor of the plaintiff's patent in examination-in-chief. This fact has also been admitted by DW3 in cross-examination.

[19] For the foregoing reasons, that is why I cannot accept that the proposition that the PVC piece gives sufficient and clear teaching to arrive at the plaintiff's patent. I do not think the PVC piece contains clear and unmistakable directions to do what the inventor of the patent's patent claims to have invented. I find myself entirely in agreement with the arguments of learned counsel for the plaintiff to the effect that the defendants have failed to establish that the plaintiff's patent has been anticipated by the PV piece. Hence, I conclude that the plaintiff's claimed invention in the plaintiff's patent is novel.

INVENTIVE STEP

[20] This brings me to the question whether or not the invention of the plaintiff's patent involves an inventive step. This is an important and crucial question which I must scrutinise closely. Generally, inventive step denotes a quality of an invention that entails technical advances or improvement as compared to the existing knowledge. The requirement for inventive step is governed by s 15 of the Act. To meet the criterion, the patentee will have to show that such inventive step would not have been obvious to a person having ordinary skill in the art. The person skilled in the art should be identified in the light of the problem that the invention is directed to solving. Obviousness is independent of anticipation. Where obviousness is in question, the area of investigation is not necessarily restricted to a single document and it may extend over an extensive field (see *ICI (Pointer's) Application* [1977] FSR 434). Obviousness is relevant only to the issue of inventive step. Even though the patented invention is not anticipated by prior disclosure, it is not patentable if it is obvious.

[21] In respect of inventive step, the case of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 laid down a four structured approach to assessing non-obviousness. The first is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the

priority date and to impute to him what was, at that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being 'known or used' and the alleged invention. Finally, the court has to ask itself whether viewed without knowledge of the alleged invention, those differences constitute steps that would have been obvious to the skilled man or whether they require any degree of invention.

[22] These are the principles which I would act upon in the present case. Indeed as obviousness is a question of fact, it must be decided objectively. Applying the foregoing principles, my views are as follows. First on the inventive concept embodied in the patent in suit. Having considered in detail the testimonies of PW1 and Mr Jeremy John Day ('PW2') as well as all the exhibits tendered, the inventive concept of the plaintiff's patent can be described as follows. The invention of a three part panel comprising of a transparent slat that is attached to two brackets in order to provide transparency whilst maintaining its strength and integrity in the joints to avoid unwanted intrusion or bad weather. The use of brackets positioned on the edges of the slat in order to maximise said visibility. The use of a uniquely configured groove on the said brackets screwed onto the complimentary-shaped edges on the slat in order to ensure a strong fixed jointing to prevent any transverse movements and to enhance the overall strength and resistance of the panels. The incorporation of interlocking scrolls onto the flanges of the brackets to provide for pivotal movement or articulation in order for the panels to function, in plurality, as a roller shutter door whilst maintaining maximum transparency and visibility. The unique configuration of the groove on the brackets ensures that the slats can only be slotted into the groove in one direction. This completely ensures that no errors will be made during assembly of the plaintiff's patented product. The tongue and groove on the edges of the slat and brackets are configured in such a manner where friction during assembly is minimised to enable easy slotting whilst preserving the reinforced fixed jointing.

[23] At this point, it needs to be made clear that on the issue of the skilled but unimaginative addressee, it is trite law that such a person is unimaginative and without even a scintilla of inventiveness. The authority to support this proposition is to be found in the case of *Technograph Printed Circuits Limited v Mills & Rockley (Electronics) Limited* [1972] RPC 346 at para 5 of p 355 as follows:

> To whom must the invention be obvious? It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with workshop technique and who has carefully read the relevant literature. He is supposed to have an unlimited capacity to assimilate the contents of, it may be, scores of specifications but to be incapable of a scintilla of invention. When dealing with obviousness,

unlike novelty, it is permissible to make a 'mosaic' out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity.

[24] Here I will mention one important point. It must be kept in mind that the 'person skilled in the art' is a legal creation. This is not a real person. It is worth emphasising that the question of obviousness is a question solely for this court to determine, hence the requirement for the court to don the mantle of the 'notional skilled addressee', (see *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd*, *Brooks v Steele & Currie* (1896) 14 RPC 46 and *Lilly Icos Ltd v Pfizer Ltd* [2001] 59 BMLR 123).

[25] In this regard, learned counsel for the plaintiff pointed out, I think quite rightly, that DW3 is a self-admitted inventor, having invented several patents and often from fields which he is not confined to. This clearly shows the somewhat enhanced inventive faculty that is possessed by DW3. This is the reason why I think DW3 does not reflect the characteristic of the non-inventive notional skilled addressee. This is an important point because it seems to me that the defendants place heavy reliance on the testimony of DW3 on the issue of assessing inventive step.

[26] At the same time, when deciding on the attributes of the notional skilled addressee, one of the essential steps is to impute to the notional skilled addressee the relevant common general knowledge which must be distinguished from public knowledge (see *General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd)*. In the present case, this must of necessity be the common general knowledge in the context of the roller shutter industry. In my view, DW3's evidence has limitations on the common general knowledge to be imputed upon the notional skilled addressee for the reason that DW3 has admitted that he is not related to the roller shutter industry. In this way, the defendants case based on obviousness by relying on DW3 failed to overcome this point of difficulty. On the other hand, PW1 is an experienced manufacturer of roller shutter doors. In his evidence he admitted that there were other types of roller shutters existing at the time when his invention was created. When asked how the other types of roller shutters work and were there any shortcomings to those designs, he explained as follows:

One of the existing roller shutters at the material time before my invention was created includes the typical metal roller shutters made of one material, that is, metal, which is not transparent. There was also another type of roller shutter at that time which is made of metal slats with ventilation holes. Sometimes, the ventilation holes are covered up with plastic. However, this design is neither safe nor is able to provide a high level of transparency.

> The existing roller shutters at that time are not transparent. As such, in order to solve this problem, extruded aluminium tube which is arranged to form a grid is used. However, this type of roller shutter does not prevent the penetration of small animals, cold wind or rain to enter through the apertures in the grid. This may cause damage to the stock in the shops.

[27] In explaining the process of inventing the plaintiff's patent, PW1 elaborated:

> The process of inventing the Plaintiff's Patent was quite lengthy, whereby I started off by drawing the features and simulating the drawings using computer software. I also made a number of proto-types of the designs using numerous types of materials at different stages.
>
> The most important feature of the curvature of the flange requires a lot of thought as it has to produce engagement means which are strong and could provide an optimum angle for rolling.
>
> My background as a mechanical engineer enables me to grasp the knowledge of materials. I have considered using glass to form the transparent shutter as part of the trial and error stages of the invention. However, it was noted that such material is not viable. Glass is not safe as it could be easily broken and the shops would have to increase their insurance premium if glass were to be used.
>
> Subsequent to the decision of using plastic to form the transparent shutter, I also took into account the grade of plastic to be used to form the transparent shutter, including the strength and thickness of the different types of plastic. The strength and thickness of the plastics were subjected and proven through breaking and impact testing. In inventing the Plaintiff's Patent, I was trying to increase the level of transparency of the roller shutters and at the same time make sure that the designs and the material used will produce roller shutters with sufficient strength. This is to make sure the shop is visible even though it is closed and yet the safety of the premises is not compromised.

[28] From all these, I gather that in the context of the present case, PW1 possess the common general knowledge of those in the roller shutter industry.

[29] This takes me back again to the case of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* and move now to identify the differences between the state of the art and the inventive concept of the plaintiff's patent. In this regard, three pieces of prior arts are relevant, namely the PVC piece, US Patent 5,456,305 (305 patent) and US Patent 4,433,714 (714 patent). Having considered in detail the testimonies of all the witnesses, in particular PW1, PW2 and DW3 well as all the exhibits tendered, the differences can be summarised as follows.

THE PVC PIECE

[30] I have earlier discussed the substantial difference between the PVC

piece and the plaintiff's patent. Hence, there is no necessity to repeat it here.

305 PATENT

Lock-Bolt hinge versus interlocking scroll

[31] The 305 Patent requires a lock-bolt to be run through the pivotal portion of the hinges. Not only does this increase the cost due to the addition of extra components, it also increases the risk of defectiveness and further costs towards the assembly line seeing as the lock-bolt must be run through accurately. By using interlocking scrolls, the plaintiff's patent reduces the need for a further component to be applied to its slats to the hinges. This will undoubtedly reduce the level of transparency and visibility as the area of opaque metal components is increased. As the configuration of the plaintiff's patent ensures that a reinforced fixed jointing can be achieved, there is no need for further strengthening. The slats can be positioned continuously without interruption and this will maximise the level of transparency and visibility. In my view, the use of interlocking scrolls and a unique groove and tongue configuration will not be obvious to the notional person skilled in the art. Although the 305 Patent appears to comprise of three components, the hinges are connected by a common lock-bolt. The workings and even the assembly of such a hinge is substantially different from that of the interlocking scrolls. Furthermore, it is inexplicable that the jagged surfaced hinge with no complementary shaped slat would make it obvious to construct a groove and tongue as configured in the plaintiff's patent, especially when the manner of assembly and the method of maintaining the jointing between the brackets and the slat are entirely dissimilar.

714 PATENT

A single piece panel versus a three part panel

[32] As the panels in the 714 Patent comprises of a completely opaque single metallic piece, there is no transparency or visibility. The plaintiff's patent on the other hand incorporates a three part panel whereby maximum transparency and visibility is possible due to the use of a separate slat and brackets.

[33] In my view, the 714 Patent is irrelevant in considering the issue of inventive step. The purpose of the 714 Patent is to provide a noise-dampening medium and does not contemplate the question of providing transparency.

[34] Now, it is the contention of the defendants that DW3 has created a mosaic (exh D27) to arrive at the plaintiff's patent. In this regard, DW3 has attempted to combine the interlocking scrolls/curled from US Patent 714

Patent with the bracket from 305 Patent in order to arrive at the plaintiff's patent. Although the concept of creating a mosaic is allowed for the question of inventive step, unlike novelty, it is trite law that the notional person skilled in the art will only attempt such a mosaic where it can be done without any capacity of inventiveness or imagination. In *Technograph Printed Circuits Ltd v Mills & Rockley (Electronics) Ltd* at para 5 of p 355, it was explained that:

> When dealing with obviousness, unlike novelty, it is permissible to make a 'mosaic' out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity.

[35] Above all else, in considering the question of obviousness, such a process cannot be carried out with the benefit of hindsight. This fundamental rule was expressed in *Non-Drip Measure Co Ltd v Strangers Ltd* (1943) 60 RPC 135 at para 40 of p 142:

> Whether there has or has not been an inventive step in constructing a device for giving effect to an idea which when given effect to seems a simple idea which ought to or might have occurred to anyone, is often matter of dispute. More especially is this the case when many integers of the new device are already known. Nothing is easier that to say, after the event, that the thing was obvious and involved no invention. The words of Moulton LJ *(British Westinghouse Co v Braulik* (1910) 27 RPC 209 at p 230) may well be called to mind in this connection:— 'I confess' (he said) 'that I view with suspicion arguments to the effect that a new combination, bringing with it new and important consequences in the shape of practical machines, is not an invention, because, when it has once been established, it is easy to show how it might be arrived at by starting from something known, and taking a series of apparently easy steps. This ex post facto analysis of invention is unfair to the inventors, and in my opinion it is not countenanced by English Patent Law'.

[36] Having stated the above, in my view, based on the significant differences between the plaintiff's patent and 305 Patent as well 714 Patent, the attempted mosaic by DW3, cannot be relied upon. The exercise undertaken by DW3 is borne from an imaginative and inventive combination of various elements; DW3 has an inventive faculty that cannot be attributed to the notional person skilled in the art. Furthermore, in my view, the exercise was undertaken by DW3 with the benefit of hindsight.

[37] The defendants contended further that the plaintiff's use of the tongue and groove method of jointing together with interlocking scrolls is an obvious combination. In this regard, it was held in *Wood v Gowshall Ltd* (1937) 54 RPC 37:

> The dissection of a combination into its constituent elements, and the examination of each element in order to see whether its use was obvious or not, is … A method which ought to be applied with great caution since it tends to obscure the fact that

> the invention claimed is the combination. Moreover, this method also tends to obscure the facts that the conception of the combination is what normally governs and precedes the selection of the elements of which it is composed, and that the obviousness or otherwise of each act of selection must in general be examined in the light of this consideration. The real and ultimate question is: is the combination obvious or not?

[38] In this regard, during cross-examination, DW3 was examined on the two purported 'common engineering concepts', ie the 'tongue & groove' method of jointing, as well as the interlocking scrolls versus the lock-bolt pivotal hinge. There is merit in the arguments of learned counsel for the plaintiff that based on the answers provided by DW3, it was clear that the shape of the tongue and groove joint would largely depend on the function it has to perform, and also dependent on types of materials. Learned counsel for the plaintiff pointed out that DW3 conceded that choosing one over another and combining it with other features could result in an invention.

[39] In this very context, PW1 in his evidence admitted he is familiar with the 'tongue & groove' concept in mechanical engineering. He further explained as follows:

> The 'tongue and groove' concept is known all along. However, depending on the characteristic of the materials, in order to have a strong joint of the two materials together, the shape of the 'tongue and groove' plays an integral part.
>
> The way the tongue and groove is designed, needs to take into account factors like material strength, the force that the roller shutter will be subjected to etc.
>
> It is only through a lot of research and development that I finally arrived at this particular shape for the tongue and groove for the Plaintiff's Patent which is different from others. So, as you can see, it doesn't mean that every 'tongue and groove' is the same or common. Depending on the function that the product is supposed to fulfil, the 'tongue and groove' can be quite uncommon.

[40] Hence, I am of the view that the contention of the defendants that the plaintiff's use of the tongue and groove method of jointing together with interlocking scrolls is an obvious combination is untenable. On the other hand, there is substance in the argument of learned counsel for the plaintiff to the effect that the plaintiff's invention cannot be simply regarded as a mere collocation as its construction and configuration had to be designed and incorporated from scratch.

[41] As a result, it is my findings that the invention of the plaintiff's patent involves an inventive step that is not obvious to a person skilled in the art.

[42] In the end, applying the patent laws as I understand it to be and taking the evidence as whole and having considered the terms of the plaintiff's patent, I conclude by saying that it stands clearly established the claimed invention is novel and inventive. That being the case, the claims of the plaintiff's patent are valid.

[43] So much about the validity of the plaintiff's patent. That leaves me to deal with the issue of passing off.

FINDINGS OF THE COURT ON THE ISSUE OF PASSING OFF

[44] As stated earlier, the plaintiff is also relying on the action of passing off. The plaintiff's claim for passing off is premised upon the features found in the plaintiff's patent claims as well as the mark 'SKB Vision 7'. It must be emphasised that the contention of the plaintiff is that passing off is not only in respect of the word 'SKB Vision 7' but encompass jointly the word as well as the features found in the plaintiff's roller shutter. It is well settled that the tort of passing off is no longer anchored to a trademark or, but encompasses other material such as visual images, provided always that such material has become part of the goodwill of the product (see *Cadbury Schweppes Pty Ltd and others v Pub Squash Co Pty Ltd* (1980) 32 ALR 387). Likewise, the features found in the plaintiff's roller shutter may be protected under the law of passing off, provided such features have become part of the goodwill of the plaintiff's product. On this issue, learned counsel for the defendants argued that the plaintiff's roller shutter incorporates functional and utility features which are not factually distinctive. I think there is substance in this line of argument. In the present case the plaintiff has not shown any evidence of distinctiveness and goodwill attached to the features found in the plaintiff's roller shutter. It has not been shown that the consumer is able to identify the features found in the plaintiff's roller shutter with the plaintiff without the aid of the plaintiff mark 'SKB Vision 7'. Furthermore, the defendants' SK-PC-7 mark, when so compared with the plaintiff's trademark 'SKB Vision 7', is distinguishable visually, aurally and conceptually. On the facts of the present case the element of misrepresentation is lacking. For all these reasons, the plaintiff's passing off claim must fail.

[45] Therefore, to sum it up, the claimed invention is novel and inventive, hence the plaintiff's patent is at all times valid and subsisting and it must inevitably follow the defendants have infringed the plaintiff's patent. Hence only this part of the plaintiff's claim is allowed with costs. I, accordingly, allow the plaintiff claims for patent infringement of the plaintiff's patent by the defendants, an injunction prohibiting the defendants from further infringing the plaintiff's patent, an order for delivery and destruction of all infringing products, inquiry as to damages or at the plaintiff's option an account of the

defendants' profits in respect of the infringement of the plaintiff's patent and interests. On the other hand, the defendants' counterclaim is unsustainable and therefore the whole of it is dismissed with costs.

Plaintiff's claim allowed in part and defendants' counterclaim dismissed with costs.

Reported by Kohila Nesan